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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/864,558

Applicant(s)

ELLIS, MICHAEL D.

Examiner

ANNAN Q. SHANG

Art Unit

2424

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 161-163, 165-187 and 192-203 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 161-163, 165-187 and 192-203 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/05/08 has been entered.

Response to Arguments

2. Applicant's arguments/amendments filed on 09/05/08 have been fully considered but are moot in view of new grounds of rejection.

With respect to claims 161-163, 165, 168-170, 173-178, 181-183, 186 and 187 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rothmuller (US 5,635,989)** in view of **Bedard (US 5,801,747)** and the various 103(a) rejections, applicant amends claims, discusses the prior arts of record and further argues that the prior arts of record do not teaches all features of the claimed invention, i.e., "...ranking based on the proportions of the programs watched..." etc., (see page 8+ of Applicant's Remarks).

In response, Examiner notes Applicant's arguments, however, the Examiner disagrees. Rothmuller monitors the durations of time a given program is selected and view and generates a favorite (interest) program list from a program guide and further

teaches other features of the claimed invention, but silent as to "ranking based on the proportions of the programs watched ..." However, in the same field of endeavor, this deficiency is disclosed in Bedard, which discloses ranking the program of interest included in the watch list based on proportions of the programs watched. Bedard teaches a viewing unit scheme for measuring the amount of time the viewer watches a program and ranks the programs accordingly (fig.2+, col. 4, lines 5-14, line 27-col.5, line 6, line 34-col.6, line 62 and col.7, line 39-col.8, line 1+). Hence the amended claims do not overcome the prior arts of record. The amendment to the claims necessitated the new ground(s) of rejection discussed below. **This office action is non-Final.**

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 161-163, 165, 168-170, 173-178, 181-183, 186 and 187 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rothmuller (US 5,635,989)** in view of **Bedard (US 5,801,747)**.

Considering claims 161 and 174, Rothmuller discloses a system and method for adding a program of interest to a watch list using an interactive television program guide at least partially implemented on user television equipment (column 4, lines 54-66), the user television equipment comprising:

A display device for displaying the program of interest (column 4, lines 54-58 and column 6, lines 60-66);

Control circuitry (15 in figure 1) configured to: determine if a user has been watching the program of interest for a specified amount of time (column 5, lines 60-67 and column 6, lines 16-27),

Determining a duration of the program of interest (by determining if the user has been watching the program of interest for a specified period of time, we also determine the duration of each program watched by the usermcolumn 5, lines 60-67 and column 6, lines 16-27); and

Automatically add the program of interest to the watch list in response to the user having watched the program of interest for the specified period of time (column 5, line 59 - column 6, lines 1-4).

Rothmuller fails to disclose ranking the program of interest based on how long the user has watched the program of interest adjusted by at least one of the duration of the programs and the type of the programs.

In analogous art, Bedard discloses ranking the programs of interest included in the watch list based on proportions of the programs watched (channel, category or subcategory (fig.2+, col. 4, lines 5-14, line 27-col.5, line 6, line 34-col.6, line 62 and col.7, line 39-col.8, line 1+).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rothmuller's system to include ranking the program of interest based on how long the user has watched the program of interest and the type of

program, as taught by Bedard, for the benefit of organizing the access of the watch list in accordance with the level of interest in each program.

As for claims 162 and 175, they are met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to automatically remove the program of interest from the watch list in response to the user not having watched the program interest for a second specified period of time (column 6, lines 48-56).

With regards to claims 163 and 176, they are met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to remove the program of interest from the watch list in response to user input (column 7, lines 10-17).

Considering claims 165 and 178, they are met by the combination of Rothmuller and Bedard. In particular, Bedard discloses that the control circuitry is further configured to place the program interest into the watch list in a position based on the ranking (fig.2+, col. 4, lines 5-14, line 27-col.5, line 6, line 34-col.6, line 62 and col.7, line 39-col.8, line 1+).

Regarding claims 168 and 181, they are met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to automatically display the watch list on the display device prior to the start of a program on the watch list (column 7, lines 39-45 and column 7, line 66 -column 8, line 2).

Considering claims 169 and 182, they are met by the combination of Rothmuller

and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to display at the top of the watch list a program that is about to start (since the favorite/watch list notification display comprises all programs that are about to start on different channels, the program displayed at the top of the favorite/watch list is a program that is about to start--column 7, lines 39 - column 8, line 2).

As for claims 170 and 183, Rothmuller discloses a method for adding a program of interest to a watch list using an interactive television program guide. Rothmuller further discloses that the viewer can maneuver a cursor on a program guide so as to highlight the program of interest (column 6, lines 64-66).

However, Rothmuller fails to disclose that the control circuitry (Microprocessor--15 in figure 1) is further configured to allow the user to highlight a program on the watch list, and simultaneously display a program the user is watching, the watch list, and information related to the highlighted program on the display device.

In analogous art, Bedard discloses that the control circuitry is further configured to allow the user to highlight (by adding a border around the program/channel window) a program on the watch list (fig.2+, col. 4, lines 5-14, line 27-col.5, line 6, line 34-col.6, line 62 and col.7, line 39-col.8, line 1+), and simultaneously display a program the user is watching (the primary television display--column 7, lines 58-60), the watch list (EPG comprising viewer preferred programs--column 7, lines 39-41), and information related to the highlighted program on the display device (see figure 5 and column 7, lines 28-64).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Rothmuller's system to include highlighting a program on the watch list, and simultaneously display a program the user is watching, the watch list, and information related to the highlighted program on the display device, as taught by Bedard, for the benefit of allowing the user to work with the watch list and simultaneously watch the primary television display (column 7, lines 58-60).

Considering claims 173 and 186, they are met by the combination of Rothmuller and Bedard. In particular, Bedard discloses that the information related to the highlighted program is a description of the highlighted program (Bedard see 508 in figure 5 and column 7, lines 34-35).

Regarding claim 177, Rothmuller discloses a method for adding a program of interest to a watch list using an interactive television program guide. Rothmuller fails to disclose ranking the program of interest based on how long the user has watched the program of interest.

In analogous art, Bedard discloses ranking the program of interest based on how long the user has watched the program (fig.2+, col. 4, lines 5-14, line 27-col.5, line 6, line 34-col.6, line 62 and col.7, line 39-col.8, line 1+),

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rothmuller's system to include ranking the program of interest based on how long the user has watched the program of interest, as taught by Bedard, for the benefit of organizing the access of the watch list in accordance with the level of interest in each program.

As for claim 187, it is met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the program of interest is a television program (column 6, lines 60-66 and column 1, lines 5-10).

As to claim 194, Rothmuller further discloses allowing the user to navigate between the programs of interest without displaying the watch list (col.7, line 59-col.8, line 22).

As to claim 195, Rothmuller further discloses asking the user context-sensitive questions before adding a program of interest to the watch list (col.7, line 59-col.8, line 22).

As to claim 196, Rothmuller further discloses asking the user context-sensitive questions before removing a program of interest from the watch list (col.7, lines 10-29).

Claim 199 is met as previously discussed with respect to claim 194.

Claim 200 is met as previously discussed with respect to claim 195.

Claim 201 is met as previously discussed with respect to claim 196.

5. Claims 166, 167, 179 and 180 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rothmuller (US 5,635,989)** in view of **Bedard (US 5,801,747)**, as applied to claim 164 above, and further in view of **Macrae (US 2003/0208756)**.

As for claims 166 and 179, Rothmuller and Bedard disclose a method for adding a program of interest to a watch list using an interactive television program guide. Rothmuller and Bedard fail to disclose that the program of interest is a promotion. In analogous art, Macrae discloses that the program of interest is a promotion

(paragraph 0291, lines 15-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Rothmuller and Bedard to include a promotion as the program of interest, as taught by Macrae, for the benefit of providing the user with various possible interests other than just television programs.

With regards to claims 167 and 180, Rothmuller and Bedard disclose a method for adding a program of interest to a watch list using an interactive television program guide.

Rothmuller and Bedard fail to disclose automatically removing the program of interest from the watch list when the promotion is no longer available. In analogous art; Macrae discloses automatically removing the program of interest from the watch list when the promotion is no longer available (Macrae [0124]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Rothmuller and Bedard to include automatically removing a program in the absence of a promotion, as taught by Macrae, for the benefit of providing a means to advertisers to renew their advertisements ([0124]).

6. Claims 171,172, 184, and 185 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rothmuller (5,635,989)** in view of **Bedard (5,801,747)**, as applied to claims 170 and 183 above, and further in view of **Billock (2002/0059581)**.

With regards to claims 171 and 184, Rothmuller and Bedard disclose a method

for adding a program of interest to a watch list using an interactive television program guide.

Rothmuller and Bedard fail to disclose that the information related to the highlighted program is a video associated with the highlighted program.

In analogous art, Billock discloses that the information related to the highlighted program is a video associated with the highlighted program (paragraph 0078, lines 4-7 and paragraph 0080, lines 1-10 and paragraph 0064, line 3 - paragraph 0068, line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Rothmuller and Bedard to include video as information related to the highlighted program, as taught by Billock, for the benefit of providing the user with different forms of information related to the highlighted program.

Regarding claims 172 and 185, they are met by the combination of Rothmuller, Bedard, and Billock. In particular, Billock discloses that the information related to the highlighted program is a video image associated with the highlighted program (Billock-- paragraph 0064, line 3 - paragraph 0068, line 5).

7. Claims 192 and 193 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rothmuller (5,635,989)** in view of **Bedard (5,801,747)**, as applied to claim 164 above, and further in view of **Lawler (5,699,107)**.

With regards to claims 192 and 193, Rothmuller and Bedard disclose ranking the programs of interest included in the watch list based on the amount of time the

programs have been watched (Bedard col.4, line 27 – col. 5, line 6 and see figure 2).

Rothmuller and Bedard fail to disclose allowing the user to set a reminder for a program of interest on the watch list.

In analogous art, Lawler discloses allowing the user to set a reminder for a program of interest on the watch list (column 2, lines 32-43, column 3, lines 37-50, column 11, lines 9-17 and see figures 8 and 9 as well as 140 in figures 6).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the combined system of Rothmuller and Bedard to include allowing the user to set a reminder for a program of interest on the watch list, as taught by Lawler, for the benefit of giving the user the option of recording the program or setting a reminder to view said program when broadcast.

8. Claims 197-198 and 202-203, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rothmuller (US 5,635,989)** in view of **Bedard (US 5,801,747)**, as applied to claim 161 and 174 above, and further in view of **Williams et al (5,945,988)**.

As to claims 197-198, Rothmuller as modified by Bedard, fail to explicitly teach creating a watch list for each of two or more users and adding a program of interest that is associated with a user to corresponding watch list of the user.

However, Williams discloses method and apparatus for updating user preferences and further discloses generating a watch list for two or more users and adding a program of interest that is associated with a user to corresponding watch list of

the user (see abstract, col.5, line 30-col.6, line 1+, col.8, line 56-col.9, line 1+, col.10, line 37-col.11, line 1+ and col.14, line 4-col.15, line 1+).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Williams into the system of Rothmuller as modified by Bedard to monitor a plurality of users as to programs of interest and create a menu or guide of programs that reflects each user's preference and furthermore to enable a plurality of users to use the same receiving unit.

Claims 202-203 are met as previously discussed with respect to claims 197-198.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maissel et al (6,637,029) discloses intelligent EPG.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ANNAN Q. SHANG** whose telephone number is **(571)272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, **call 800-786-9199 (IN USA OR CANADA) or 571-272-1000**.

/Annan Q Shang/

Primary Examiner, Art Unit 2424

Annan Q. Shang